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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/700,113 | 02/16/2001 | Shou-Wei Ding | 2577-114 | 2556 |

6449 7590 07/13/2005

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EXAMINER

HELMER, GEORGIA L

ART UNIT PAPER NUMBER

1638

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/700,113 | Applicant(s) DING, SHOU-WEI | |
| | Examiner Georgia L. Helmer | Art Unit 1638 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24, 26, 30 and 32-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24, 26, 30 and 32-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |



5.00

Status of the Claims

1. The Office acknowledges receipt of Applicants Response; dated 27 April 2004. Applicant has amended claims 24, 26, 30 and 32-33. Claims 24, 26, 30 and 32-43 are pending, and are examined in the instant action.
2. This action is made FINAL necessitated by Applicant's amendment.
3. All rejections not addressed below have been withdrawn.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 24, 26, 30, and 32-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection. The rejected subject matter is "nucleotides 20-304 of SEQ ID NO: 1" and "nucleotides 6-305 of SEQ ID NO: 4". Applicant is invited to point out the page and line number in the specification where is "nucleotides 20-304 of SEQ ID NO: 1" and

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"nucleotides 6-305 of SEQ ID NO: 4" can be found. Absent such support, Applicant is required to cancel the new matter in response to this Office Action.

Claim Rejections - 35 USC § 112-Enablement

7. Claims 24, 26, 30, and 32-43 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, for reasons set forth. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant traverses the unpredictability as set forth in the Office Action of 12 February 2003, saying (Response of 27 April 2005, p. 7) that the Agrios reference does not support Examiner's statement. The 12 Feb 2003 Office Action is repeated in part below:

The enablement issues are: expression of the two-domain gene under control of a promoter activated by infection with a plant pathogen, any pathogenic organism, and transgenic plants other than tomato and tobacco.

Applicant traverses analyzing the predictability of the system in a piece-meal fashion, saying that "plant active promoters are well know in the art", that "promoters are selected on the host and are selected to be operable in the host", submitting that the Office has offered no scientific reasoning or basis to rebut the teachings of these references and thus the enablement of the claims directed to the expression vector". Applicant's traversal is unpersuasive. The written record is replete with sound scientific reasoning and references supporting the unpredictability.

Applicant traverses saying primarily (Response, p. 10) that , "contrary to the statement by the Examiner , the specification does include a teaching of a two-domain gene under control of a plant pathogen activated promoter, citing p. 13, line 33-p.14, line 6. Applicant's traversal is unpersuasive. The specific relevance of the cited material is not apparent. Applicant is encouraged to further clarify.

Furthermore, it is the unpredictability of the system as a whole (the host plant + the regulatory sequences/promoter causing expression when plant infected with pathogenic organism + DNA encoding a 2-domain protein + the pathogenic organism), which is the claimed invention, that is the issue. Whereas any given step may function "perfectly", it is the success the sum of the steps which is required to enable the claimed invention.

Remarks

8. No claims are allowed.
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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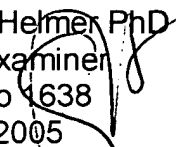
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 571-272-0796. The examiner can normally be reached on Monday-Thursday 10-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones at 571-272--745. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Georgia Helmer PhD
Patent Examiner
Art Group 1638
July 11, 2005




ELIZABETH MCELWAIN
PRIMARY EXAMINER